

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.09/454,221
Filing DateDecember 9, 1999
InventorshipAppiah et al.
Appellant..... Microsoft Corporation
Group Art Unit2142
ExaminerWillet/Rinehart
Confirmation No.3503
Attorney's Docket No.MS1-435US
Title: Printer Driver Identification For A Remote Printer

REPLY BRIEF

To: Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

From: Paul W. Mitchell (Tel. 509-324-9256; Fax 509-323-8979)
Customer No. 22801

In response to Examiner's Answer mailed November 16, 2005, in connection with Applicant's Appeal Brief filed August 15, 2005, a Reply Brief is submitted. Favorable consideration is respectfully requested. The Examiner's Answer included new grounds for rejection which are addressed herein. Applicant respectfully requests that the present appeal be maintained.

Response to Arguments in Examiner's Answer

Appellant herein makes a good faith effort to respond to the Examiner's Answer. However, Appellant respectfully ponders whether an Examiner's Answer is the appropriate venue to change the rejections of the present Application and to provide explanations in the record which should have been provided at the time the rejections were made.

Beginning on page 4 section (9) of the Examiner's Answer (Mailed November 16, 2005), the examiner relays 16 points (1-16) under the heading of "Grounds of Rejection". On page 14 the Examiner's Answer states that "this examiner's answer contains a new ground of rejection set forth in section (9)". Which of the 16 points of section (9) contain new grounds of rejection is not specified. Applicant herein makes a good faith effort to respond to all of the Examiner's continuing and new grounds for rejection. Specific points within section 9 are discussed below.

Section (9), page 4, points 1-2

The Examiner's Answer raises a new ground of rejection of claims 1, 15, 26, 33, and 35 based on the §112 1st paragraph written description requirement (rather than the previous enablement rejection). In Section (10) "Response to Arguments" at point 17 the Examiner casually states that the "§112 enablement rejection should have been a 112 written description rejection" and as such unfortunately does not substantively address Applicant's response. Accordingly, Applicant once again respectfully responds that the claims at issue are sufficiently described to meet the requirements of §112.

Appellant respectfully submits that the Examiner fails to establish a *prima facie* case for a §112 written description rejection in the Examiner's Answer. First, the Office has failed the initial burden to establish a reasonable basis to question the written description provided by the claimed invention. Second, the written description rejection is erroneous in light of the originally filed specification. For the reader's convenience, the subject matter of Claim 1 is provided below as representative of a claim containing the rejected language. By reciting claim 1, Appellant is not implying that claims 1, 15, 26, 33, and 35 have the same claim scope. Rather, claim is provided for discussion purposes as these claims are rejected under §112 as a group rather than individually.

Claim 1 recites a method in a server-client environment, the method comprising:

- receiving at the server a driver identifier for a printer that is attached to the client;
- using the driver identifier to select a closest matching driver of a plurality of drivers to install at the server; and
- installing, at the server and not at the client, the selected driver in order to enable applications executing on the server to print to the printer using the installed driver.

The Examiner contends that "installing...not at the client" is "not written in the Specification". Applicant respectfully disagrees that the claim language at issue is not supported by the disclosure as originally filed. Applicant also respectfully notes that Applicant submitted a detailed discussion of the described subject matter in relation to the Examiner's previous enablement rejection. Applicant notes that the Examiner summarily dismissed the Appellant's discussion

in direct contravention to MPEP §2163.04 II which states that “upon reply by Applicant...review the basis for the rejection in view of the record as a whole”.

The standard for a written description rejection is that “each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure.” MPEP §2163.05. Appellant respectfully contends that the Office’s §112 written description rejection is erroneous in light of Appellant’s originally filed specification and drawings (excerpts of each are provided below). The Specification beginning on page 6 describes a server/client system 50 having a server 52 and a client 54. (Specification, Pg. 6, lines 10-12). (The designator 32 is utilized for the server in relation to Fig. 1 and designator 52 is utilized in relation to Fig. 2, the client is handled in a similar manner). The specification further describes:

The server 32 is a computer. A client 34, 36 may be a computer having Plug and Play capability, a computer that is not Plug and Play compatible, or a terminal, which does not have the processing capability of a computer. (Pg. 5 lines 13-16).

The server 32 is configured to provide a logically independent machine for each client 34, 36 connected to the network 38. That is, the server 32 establishes a session for each client 34, 36, provides the desktop 40, 42 for each client 34, 36, and makes server resources available to the clients 34, 36. Such resources include, but are not limited to, allocations of processor time, memory, data storage, video processing, application programs, etc. A user of either of the clients 34, 36 interacts with the desktop 40, 42 on the client 34, 36 to run software applications that reside on the server 32. While the user provides input to and receives output from the client 34, 36, most processing is performed at the server 32. (Page 5 line 22 – Page 6 line 5).

The server 52 is shown having a printer driver 70 and a printer queue 72 installed and resident within the memory 58. (Pg. 7 lines 5-6). The printer driver 70 is a printer-specific software program that provides an interface between a printer and the server 52 and allows the server 52 to provide print functions via the printer. (Pg. 7 lines 8-11).

Applicant further provides below a copy of Fig. 2 as originally filed. Applicant notes that Fig. 2 illustrates a server/client system 50 where a print driver 70 is installed at the server 52 and not at the client 54. One of skill in the art can recreate the claimed invention as defined in the subject claims from Fig. 2 and the supporting description as originally filed.

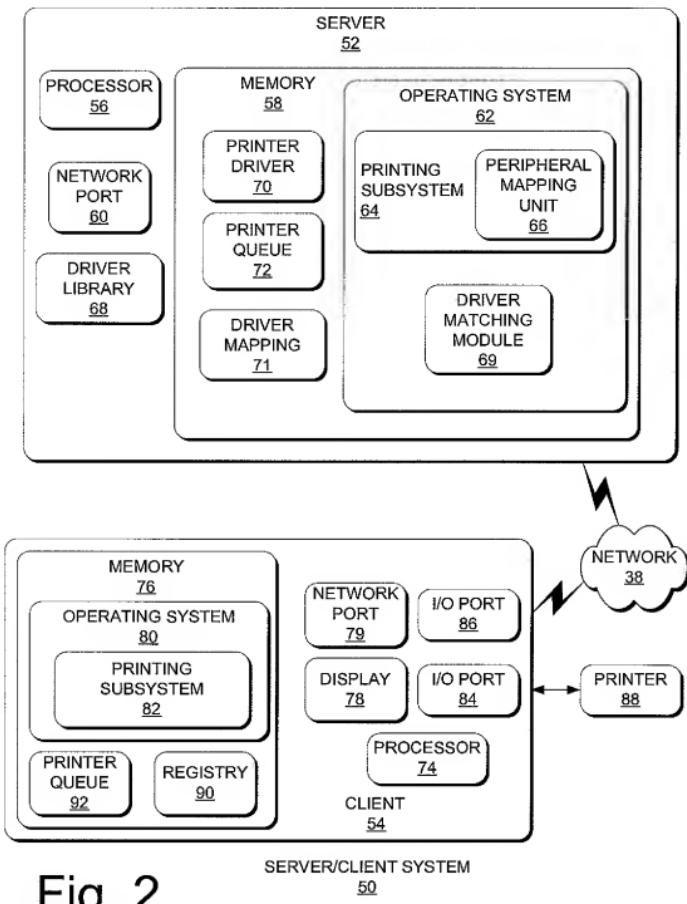


Fig. 2

The above cited description from the specification and Fig. 2 both consistently

describe a scenario where a printer driver 70 is installed at the server (32 and 52) and not at the client (34 and 54). Was this purposeful or was it mere oversight that was leveraged by the Applicant to avoid obvious elements of a reference as suggested by the Examiner In the Examiner's Answer at page 13 line 8? The definition of a print driver as contained in the above text sheds further light on this issue. "The printer driver 70 is a printer-specific software program that provides an interface between a printer and the server 52 and allows the server 52 to provide print functions via the printer." Given this definition, a print driver on the client would have no function. As such, the definition of a print driver is consistent with the print driver being installed on the server and not on the client as it provides an interface between a printer and the server. Accordingly, the original specification provides implicit support to such a configuration where a print driver is installed on the server and not on the client in satisfaction of MPEP §2163.05.

Consider further an example of an implementation described in the specification and upon which claim 1 reads. Such an example is commonly referred to as a "terminal session scenario" or similar moniker. Consistent with this example a server 32 is a computer. (Pg. 5 lines 13-16). A client 34 may be a computer having Plug and Play capability, a computer that is not Plug and Play compatible, or a terminal, which does not have the processing capability of a computer. (Pg. 5 lines 13-16). The server 32 is configured to provide a logically independent machine for the client 34. That is, the server 32 establishes a session (e.g. terminal session) for the client 34, provides the desktop 40 for the client 34, and makes server resources available to the client 34. Such resources include, but

are not limited to, allocations of processor time, memory, data storage, video processing, application programs, etc.

A user of the clients 34 interacts with the desktop 40 on the client 34 to run software applications that reside on the server 32. While the user provides input to and receives output from the client 34 most processing is performed at the server 32. (Page 5 line 22 – Page 6 line 5). The server 52 is shown having a printer driver 70 and a printer queue 72 installed and resident within the memory 58. (Pg. 7 lines 5-6). The printer driver 70 is a printer-specific software program that provides an interface between a printer and the server 52 and allows the server 52 to provide print functions via the printer.

Claim 1 reads on such a terminal session scenario, where the print driver is installed at the server and not at the client. Such a configuration allows the user to print on a printer attached to the client even though the actual processing is occurring at the server rather than the client. In such an example, a device can function as a client without having processing and memory resources for communicating with a printer which is physically coupled to it.

Applicant respectfully submits that the disclosure as originally filed supports the rejected claims and provides examples of implementations upon which the rejected claims read without any need to look for external definitions. Accordingly, Appellant respectfully requests that the §112 rejection be overturned.

Section (9), page 5, points 3-6

Beginning formally at point 3 and with specificity at points 6-7, the Office apparently withdrew its §102 rejection of claims 1, 2, 14-17, 26-28, and 33-35 and then rejected these claims under §103. Applicant has previously addressed the §102 rejections and herein addresses the newly raised §103 rejections. The Examiner's answer suggests that a combination of Poger and Kathail teaches all of the features of claims 1, 2, 14-17, 26-28, and 33-35. Applicant submits that the art of record does not render obvious the claimed subject matter.

Appellant respectfully submits that the Examiner fails to establish a *prima facie* case of obviousness for rejecting Claims 1, 2, 14-17, 26-28, and 33-35 in the Examiner's Answer for at least two reasons. The Office fails to establish a *prima facie* case of obviousness since the suggested combination fails to teach all of the claim elements of Claims 1, 2, 14-17, 26-28, and 33-35. Second, the Office fails to identify any motivation from the references for the Office's suggested combination. The Examiner's answer at point 6 rejects independent claims 1, 15, 26, 33, and 35 based upon a single argument (and also dependent claims 14, 16-17, 27-28 and 34). For the sake of brevity in this reply brief, Appellant has attempted to follow the Examiner's organization. Appellant has reproduced claim 1 below for discussion purposes. The other claims may have additional and/or different patentable features from those of claim 1.

Claim 1 recites a method in a server-client environment, the method comprising:

- receiving at the server a driver identifier for a printer that is attached to the client;

- using the driver identifier to select a closest matching driver of a plurality of drivers to install at the server; and
- installing, at the server and not at the client, the selected driver in order to enable applications executing on the server to print to the printer using the installed driver.

Appellant submits first that Poger does not relate to a server-client environment as recited in claim 1. Poger describes automatically installing a network hardware device on a network server used to operate the network device. Col. 2 lines 7-11. Poger defines a network device as a “variety of system resources, including hardware devices, e.g. a magnetic disk drive device, and display devices. Col. 1 lines 15-17. Poger does not contemplate a server-client environment as specified in claim 1. Further, Poger does not contemplate a printer attached to a client as recited in claim 1 in order to enable applications executing on the server to print to the printer using the installed driver. Instead, Poger teaches installing a device on a network such that an associated software driver 148 for the device resides on configuration server 110 and upon the device as software driver 160. Col. 3 lines 61-67.

Further, even considering arguendo that Poger’s network hardware device system is analogous to the server client environment of claim 1, Appellant submits that claim 1 recites installing, at the server and not at the client, the selected driver in order to enable applications executing on the server to print to the printer using the installed driver. Fig. 2 of the present Application provides at least one example of an implementation upon which claim 1 reads. Contrastingly, Poger states that driver software 160 resides on both the configuration server 110 and the network device 115. Col 3, lines 65-67. This statement is consistent with Poger’s

Fig. 1 which shows driver software resident on network device 115 at 160 and on configuration server 110 at 148.

The Examiner suggests that Poger teaches “not installing at the client as not requiring additional software at the network device/client”. Examiner’s Answer, Page 6 lines 16-18. Applicant respectfully submits that the Examiner is misconstruing Poger’s text. The cited text states that the invention does “not require all network devices to include additional software [emphasis added]”. Col. 3, lines 1-3. The statement has nothing to do with the device’s own software. Instead, the statement relates to an earlier passage about the shortcomings of existing network configurations which states “for one network device to control another network device, the first device must therefore have installed on it the driver software corresponding to the device it wishes to control.” Col. 1 lines 39-46. As such Poger’s text as cited by the Examiner relates to not having to install additional software drivers on particular device’s to allow communication between the devices since the additional software resides on the communication server 110. For at least these reasons, Poger does not teach the features of claim 1.

Next, Applicant respectfully submits that the Examiner’s suggested combination of Poger with Kathail does not provide the missing claim features. The Examiner brings in Kathail to teach a “printing device”. Examiner’s Answer page 6 lines 24-25. However, in the 1/13/04 Office Action, the Office stated “Kathail teaches the invention in the above claim(s) except for explicitly teaching installing a print driver on the server side for printing at the client printer”. (1/13/04 Office Action, Page 3, Lines 10-11 of Point #4). The Office has expressly stated that Kathail does not describe the feature which the Office

subsequently looks to Kathail to provide. Since, Poger and Kathail both fail to teach “installing, at the server and not at the client, the selected driver in order to enable applications executing on the server to print to the printer using the installed driver” the proposed combination of Kathail with Poger fails to teach all of features recited in claim 1. For at least this reason, Appellant respectfully requests that the §103 rejection of claim 1 be overturned.

Further, the Office provides an insufficient basis for combining Poger and Kathail. The Office’s states “the motivation to incorporate matching print driver insures that distributed processing in an open platform is supported, especially with thin-clients.” Appellant respectfully notes that the Office continues to identify any motivation from the art for the proposed combination. Lacking any motivation in the record from the art for the proposed combination, Applicant respectfully submits that the Examiner is using hindsight reconstruction in attempt to piece together the features recited in claim 1. Appellant respectfully submits that the Office has failed to establish a *prima facie* case for a §103 rejection for at least this additional reason. Appellant respectfully requests that the §103 rejection be overturned for at least this additional reason.

Section (9), page 7, point 7

Claim 2 recites wherein the receiving comprises receiving the driver identifier from the client. Appellant respectfully submits that the art of record does not teach or suggest such a feature. Specifically, the art of record is silent as to a server-client relationship generally and specifically the server receiving the driver identifier from the client. In such a scenario, the Examiner’s assertion that a

driver identifier is analogous to a unique hardware address does not address the insufficiency of the art of record in describing the features of claim 2. Accordingly, Appellant respectfully requests that the rejection be overturned.

Section (9), page 7, point 8

Claims 3, 9, and 37 depend from allowable base claims and as such are allowable for the reasons described above. These claims recite further features which are not taught or suggested by the art of record. Further, even considering arguendo that these features are described by the Examiner's proposed combination of Poger and Kathail, the record is devoid of motivation to combine the references. The Office contends that “[t]he motivation to incorporate matching of drivers [sic] types insures that distributed processing in an open platform is supported especially in thin-clients.” Appellant respectfully notes that neither reference contains the terms “distributed processing”, “open platform” or “thin-client”. In contravention to MPEP 2143.01 the record is devoid of evidence for motivation to combine the references as suggested by the Office at the time of the present invention. Appellant respectfully submits that the Office has failed to establish a *prima facie* case for a §103 rejection in accordance with MPEP § 2143. Appellant respectfully requests that the §103 rejection be overturned for at least this reason.

Section (9), page 7, points 9-16

Claims 4-8, 10-13, 18-24, 29-32, 36, and 38-40 are rejected on a similar basis to the claims described above. These claims recite features which are not

taught or suggested by the art of record. Further, even considering arguendo that these features are described by the Examiner's proposed combination of Poger and Kathail, the record is devoid of motivation to combine the references. The Office contends that “[t]he motivation to incorporate matching of drivers [sic] types insures that distributed processing in an open platform is supported especially in thin-clients.” Appellant respectfully notes that neither reference contains the terms “distributed processing”, “open platform” or “thin-client”. In contravention to MPEP 2143.01 the record is devoid of evidence for motivation to combine the references as suggested by the Office at the time of the present invention. Appellant respectfully submits that the Office has failed to establish a *prima facie* case for a §103 rejection in accordance with MPEP § 2143. Appellant respectfully requests that the §103 rejection be overturned for at least this reason.

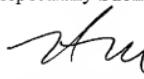
Conclusion

Appellant respectfully submits that all of the Examiner's rejections have been traversed. As such, Appellant respectfully submits that all of the claims are in condition for allowance.

Respectfully Submitted,

Dated: 1/17/06

By:


Paul W. Mitchell
Lee & Hayes, PLLC
Reg. No. 44,453
(509) 324-9256 ext. 237